RESPONSE

A restriction requirement was made by the Examiner. Applicants affirm the election of the invention of Group II, claims 1-11 drawn to compositions comprising amides. Applicants respectfully point out that claims 4, 5, 6 and 10 are drawn to processes or methods wherein said process or method uses amides. Applicants acknowledge and kindly thank the Examiner for examination of claims 4, 5, 6 and 10.

Claims 1-11 are pending in the present application. Claims 1-7, 10 and 11 have been rejected. The Examiner has withdrawn claim 8 from consideration and objected to claim 9. Claims 1-7, 11 have been amended and claim 8 has been deleted.

The Examiner has rejected claims 1-7, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over EP 612, 839 A1. In order to establish prima facie obviousness, three criteria must be met. First, there must be suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991). EP '689 does not teach, nor does it suggest Applicants' claimed invention, nor does it suggest a reasonable expectation of success. Withdrawal of the rejection is respectfully requested.

EP 612,839 (hereinafter "EP '689") discloses a composition that may comprise a fluorine-containing hydrocarbon; a fatty amide, and a lubricant. The amides of EP '689 are of high molecular weight, compared to the amides of the Applicants' invention. Additionally, the compositions of EP '689 comprise carboxylic ester, polyoxyalkylene glycol, polycarbonate lubricants or mixtures thereof. EP '689 teaches on page 2, lines 21-34 that the disclosed compositions still require the use of additives to provide wear protection to compressors and improve compressor efficiency. Possible additives for the disclosed compositions also include viscosity adjusters and viscosity improvers.

Applicants claimed invention comprises at least one lubricant and at least one amide compatibilizer. The amides of Applicants' invention have a molecular weight of from about 120 to about 300. Applicants' invention addresses the expense and unfavorable consequences caused by the hygroscopic nature of polyalkylene glycol lubricants, as discussed in the present

specification beginning on page 1, line 29 and continuing to page 3, line 21. At page 11, line 22, Applicants disclose suitable lubricants for the claimed invention, none of which are disclosed in EP '689.

The Examiner's rejection reasons that a substantial amount of additive would be necessary to adjust the viscosity of the lubricant of Applicant's invention. Applicants respectfully point out that EP'689 acknowledges on page 2, line 19 that the presence of the carbon-hydrogen bond in HFCs greatly reduces their miscibility with lubricants that were used with CFCs. Indeed, one skilled in the art would not have a reasonable expectation of success by using any significant amount of napthenic or alkyl benzene oil, which are covered by Applicants' claims, and which have been used with CFCs, as acknowledged by EP '689.

EP '689 discloses compositions that comprise additives to impart properties that are needed when using HFC-compatible lubricants. Applicants' invention is directed to compositions comprising lubricants selected from the group consisting of paraffins, napthenes, aromatics and poly-α-olefins, which alone are not compatible with HFCs. Assuming the Examiner had made out a prima facie case of obviousness, Applicants rebut the rejection. The need for an efficiency improving or wear reducing additive with the HFC compatible lubricants as expressly disclosed in EP '689 teaches away from Applicants' claimed invention, which is directed to compositions comprising different lubricants that also unexpectedly results in compressor oil return.

REMARKS

Applicants believe they have overcome the Examiner's rejections of claims 1-7, 10 and 11. As a result, Applicants believe that claim 9 is no longer dependent upon a rejected claim. In view of the foregoing, withdrawal of the rejection and allowance of claims 1-7, 9, 10 and 11 are respectfully requested.

Respectfully submitted,

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